

- (3) Claims 1-4, 11-12, 23-30 and 59-64 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,798,324 (Svoboda);
- (4) Claims 1-4, 11-12, 23-26, 49-52, 59-60 and 62-63 under 35 U.S.C. §102(b) as anticipated by EP 0 527 625 (Cummings);
- (5) Claims 5-8, 15-18, 31-34, 41-44 and 53-56 under 35 U.S.C. §103(a) over Neumiller '681 as applied to the above claims;
- (6) Claims 9-10, 13-14, 19-22, 35-36, 45-46 and 57-58 under 35 U.S.C. §103(a) over Neumiller '681 as applied to the above claims, and further in view of U.S. Patent No. 5,716,921 (Neumiller '921);
- (7) Claims 11-12 and 27-36 under 35 U.S.C. §103(a) over Michael as applied to the above claims;
- (8) Claims 9-10, 13-14, 19-22, 45-46 and 57-58 under 35 U.S.C. §103(a) over Michael as applied to the above claims, and further in view of Neumiller '921; and
- (9) Claims 59-65 under 35 U.S.C. §103(a) over Neumiller '681 or Michael as applied to the above claims, and further in view of Svoboda.

The pending independent claims are claims 1, 2 and 62 which each claim a hard surface cleaning composition.

The compositions of claims 1 and 2 include (1) at least one

low-volatile non-VOC evaporative organic solvent that has limited solubility in water of less than 20% and reduces surface tension of the composition to less than 40 dynes/cm, (2) at least one surfactant, and (3) an aqueous courier, wherein the composition has less than about 4% by wt. volatile organic compound (VOC) content. The composition of claim 62 includes (1) at least one low volatile and/or high volatile evaporative organic solvent having limited solubility in water of less than 20% and reduces surface tension of the composition to less than 40 dynes/cm, (2) at least one surfactant, (3) at least one co-solvent that is a low-volatile non-VOC solvent which has at least a different water-solubility or different surface tension reduction capacity from the solvent of (1) above, (4) a polymer or copolymer, and (5) an aqueous carrier, wherein the composition has less than about 4% by wt. VOC content.

The primary references applied are Neumiller '681, Michael, Svoboda and Cummings which are each applied alone under 35 U.S.C. §102. Each of these references describe a glass or hard surface cleaner disclosed as including, among other things, a combination of a surfactant and solvent where the solvent can be selected from varying compounds set forth therein. These primary references do not recognize the problem being addressed by applicants, do not teach the

VOC content of the composition much less teach that the VOC content is less than about 4% by wt., do not teach that at least one solvent included is an evaporative organic solvent having limited solubility in water of less than 20% and reduces the surface tension of the composition to less than 40 dynes/cm, and do not teach that when a co-solvent is present it has at least a different water-solubility or different surface tension reduction capacity from the required evaporative organic solvent. Each of the primary references teaches the ability to include in the cleaners disclosed therein varying solvents which may or may not fall within the applicants' claimed evaporative organic solvent or combination of solvents. The primary references do not provide any distinction between the solvents disclosed therein based on volatility, water solubility or surface tension reduction capacity. To the extent Cummings requires the inclusion of ethylene glycol monohexyl ether, Cummings also teaches other solvents, e.g. alcohols, glycols and glycol ethers, not meeting the claimed solvent limitations and resulting in a VOC content outside the claimed amount of less than about 4% by wt. Accordingly, applicants submit that each of the applied primary references of Neumiller '681, Michael, Svoboda and Cummings do not teach each and

every element of the claimed composition and, thus, do not anticipate the claims within the meaning of 35 U.S.C. §102.

The Court in In re Arkley, 172 USPQ 524, 526 (CCPA 1972) in considering a rejection under 35 U.S.C. §102(b), stated:

"It is to be noted that rejections under 35 U.S.C. §103 are proper where the subject matter claimed "is not *identically* disclosed or described" (emphasis ours) in "the prior art," indicating that rejections under 35 U.S.C. §102 are proper only when the claimed subject matter *is* identically disclosed or described in "the prior art." Thus, for the instant rejection under 35 U.S.C. 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound with any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited references."

Note also In re Bond, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

Further, the Examiner asserts that the compounds disclosed in the reference should "inherently" possess the claimed limitations. While a prior art reference which does not set forth a particular element of the claim may anticipate if that element is "inherent", the Court of Appeals For the Federal Circuit has stated In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1999) that -

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749

(Fed. Cir. 1991). 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' Id. At 1269, 948 F.2d, 1264. 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981))." (emphasis added)

Also noted is Mehl/Biophile International Corp v. Milgraum, 52 USPQ2d 1303, 1305-1306 (Fed. Cir. 1999) and Transclean Corp. v. Bridgewood Services, Inc., 62 USPQ2d 1865, 1871 (Fed. Cir. 2002).

In view of the lack of recognition of the problem to be solved in each of Neumiller '681, Michael, Svoboda and Cummings, as well as the lack of any teaching regarding the disclosed compositions being required to have a VOC content of less than about 4% by weight and that an evaporative solvent be present which has a solubility in water of less than 20% and reduces surface tension of the composition to less than 40 dynes/cm, applicants submit that at the most only probabilities or possibilities could result since there is no teaching to direct one skilled in the art as to which of the various components should be selected from the disclosure and in what combination these components should be present, in particular the solvents, in order to obtain applicants' claimed composition.

Thus, applicants respectfully submit that none of Neumiller '681, Michael, Svoboda or Cummings anticipates the

claimed compositions within the meaning of 35 U.S.C. §102. Withdrawal of the §102 rejections based individually on Neumiller '681, Michael, Svoboda and Cummings is, therefore, requested.

The remaining rejections are under 35 U.S.C. §103 over Neumiller '681 or Michael alone, or Neumiller '681 or Michael in combination with Neumiller '921 or Svoboda. Neumiller '921 is relied on for suggesting an additional limitation of a dependent claim regarding the amphoteric surfactant disodium cocoamphodipropionate. Accordingly, applicants submit that Neumiller '681 and Michael alone or in combination with Neumiller '921 or Svoboda do not teach or suggest the claimed compositions as set forth above. Neumiller '921 does not make up for the shortcomings of the primary references. Further, as the Court in In re Newell, 13 USPQ2d 1248, 1250 (Fed Cir. 1989) stated -

"It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. 'That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.' In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)."

"The determination of whether a novel structure is or is not 'obvious' requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art."

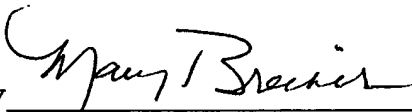
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Accordingly, applicants further submit that the claims as rejected under 35 U.S.C. §103 are not rendered obvious within the meaning of §103 and, therefore, respectfully request withdrawal of the §103 rejections.

Reconsideration and allowance of the claims is respectfully urged.

Respectfully submitted,

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